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EXAMINER

ZHONG, CHAD

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 12/02/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,959

Applicant(s)

PAREKH, SANJAY M.

Examiner

Chad Zhong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4,5,6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-12 are presented for examination.
2. The specification is objected to because of the following: current US patent policy does not permit the use of hyperlinks in the specification. Such links are directed to an Internet site, the contents of which are subject to change without notice. Therefore, the potential for inclusion of new matter would be a constant problem. See page 10, for example. Correction is required.
3. The use of the trademark Starcom International Optics Corp., Worldway Holdings Inc. among others have been noted in this application (pg 17). It should be capitalized wherever it appears and be accompanied by the generic terminology. Appropriate correction is required.
4. The drawing is objected to because of the following informalities:

It is not clearly understood why information is retrieved at 125 when determination system (30) considers it a match indicated on page 20 lines 20-22 (i.e. does the applicant mean 126?); It is not clearly understood why the geographic information is delivered to the requestor 40 at 126 (i.e. does the applicant mean 127?).

Item 128 is not located on figure 5 as stated in pg 21 lines 1-2. Appropriate correction is required.

Claim Rejections - 35 USC § 112, first paragraph

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

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written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As per claim 7, Fig. 16 and pg 41 lines 19-23 have not suggested the notion of sending geographic location to the Internet user's machine; and redirecting the Internet user's machine to the external network. Also refer to 103 rejection for claim 7.

Claim Rejections - 35 USC § 112, second paragraph

7. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lack antecedent basis:

- i. the Internet user's machine – claim 2, 7.
- ii. the Internet – claim 1, 3.
- iii. the Internet user's internal address – claim 5.

b. The claim language in the following claims is murky or not clearly understood:

- i. As per claim 1, lines 3, 4, 5, 7, it is not clearly understood which device is receiving, determining, redirecting and receiving respectively (i.e. is the end website outside of private network?).
- ii. As per claim 2, line 3, it is not clearly understood which device is receiving a request (i.e. DNS server?); line 5, it is not clearly understood which device is detecting the request for the geographic location of the Internet user was redirected from the external network (i.e. DNS server?).
- iii. As per claim 8, it not clearly understood how after receiving a request for the geographic

location of the Internet user from a requestor outside of the private network can we determine that the request for the geographic location is from the Internet user located inside the private network having the proxy server? (i.e. there seem to be a contradiction, appropriate correction is required).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCanne et al. (hereinafter McCanne), US 6,415,323, in view of Lamm et al. (hereinafter Lamm), "Real Time Geographic Visualization of World Wide Web Traffic", WWW Journal Issue 3.

10. As per claim 1, McCanne substantially teaches the invention as claimed wherein a method for obtaining a geographic location of an Internet user that accesses the Internet from a private network through a server, comprising:

receiving a request for information from an Internet user through server (Col. 8, lines 17-22).

determining that the request for information is through the server (Col. 9, lines 40-42);

redirecting the request for information to an internal server of the private network (Col. 8, lines 17-22);

11. McCanne does not teach the method to use a proxy server. However, it would have been obvious to one of ordinary skill in this art at the time of invention to include proxy server doing so would

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improve the security of McCanne's system limiting internet access through the usage of a proxy behind a firewall.

12. McCanne does not teach the internal server determining the geographic location of the Internet user; receiving the geographic location from the internal server within the private network; and using the geographic location of the Internet user in handling the request for information from the Internet user.

13. Lamm teaches the internal server determining the geographic location of the Internet user (pg 3, "Geographic Location Mapping", 2nd and 4th paragraph); receiving the geographic location from the internal server within the private network; and using the geographic location of the Internet user in handling the request for information from the Internet user (pg 3, "Motivations", 2nd paragraph).

14. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of McCanne and Lamm because they both dealing with servers offering services towards a client request. Furthermore, the teaching of Lamm to allow internal server determining the geographic location of the Internet user; receiving the geographic location from the internal server within the private network; and using the geographic location of the Internet user in handling the request for information from the Internet user would improve the functionality for McCanne's system by extending the server services which was generically stated in McCanne to discovery of geographic location of clients.

15. As per claim 2, McCanne teaches wherein redirecting the request for information to the internal server comprises sending the request for information to the Internet user's machine, the Internet user's machine directing the request for information to the internal server (Col. 3, lines 64-66; Col. 5, lines 2-3; Col. 8, lines 17-22; Col. 11, lines 57-65).

16. As per claim 3, McCanne teaches the method substantially as claimed wherein a method for determining a geographic location of an Internet user that accesses the Internet from a private network through a server, comprising:

receiving a request within the private network, the request originating from an external network outside of the private network (Col. 12, lines 25-30);

detecting that the request for the geographic location of the Internet user was redirected from the external network (Col. 9, lines 40-42; Col. 8, lines 17-22);

17. McCanne does not teach the request is a geographic location of the Internet user; determining the geographic location of the Internet user; and sending the geographic location to the external network.

18. Lamm teaches the request is a geographic location of the Internet user; determining the geographic location of the Internet user (pg 3, "Geographic Location Mapping", 2nd and 4th paragraph); and sending the geographic location to the external network (pg 3, "Motivations", 2nd paragraph).

19. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of McCanne and Lamm because they both dealing with servers offering services towards a client request. Furthermore, the teaching of Lamm to allow request is a geographic location of the Internet user; determining the geographic location of the Internet user; and sending the geographic location to the external network would improve the functionality for McCanne's system by extending the server services which was generically stated in McCanne to discovery of geographic location of clients.

20. As per claim 4, McCanne teaches wherein receiving the request for the geographic location originating from the external network comprises receiving the request from the Internet user's machine

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(Col. 8, lines 17-22; Col. 12, lines 25-30).

21. As per claim 5, Lamm teaches wherein determining the geographic location comprises determining the geographic location based on the Internet user's internal address and a geographic location/internal IP address mapping table contained within the private network (pg 3, "Geographic Location Mapping", 2nd and 4th paragraph).

22. As per claim 6, Lamm teaches wherein determining the geographic location comprises:
determining an internal address of the Internet user; and
accessing a geographic location/internal IP address mapping table contained within the private network (pg 3, "Geographic Location Mapping", 2nd and 4th paragraph).

23. As per claim 7, McCanne and Lamm does not teach wherein sending the geographic location to the Internet user's machine; and redirecting the Internet user's machine to the external network. However it would have been obvious to one of ordinary skill in this art at the time of invention to send geographic information to client's machine first and send newly acquired geographic information towards external network/web server because doing so would be essential in certain network environments. Take a DHCP network for example, where IP addresses of client machines are updating periodically, so it is necessary and obvious in this case to send the newly acquired geographic information to the client first and having the client send said geographic information along with its own identification to external network.

24. As per claim 8, McCanne teaches the invention substantially as claimed wherein a method for obtaining a geographic location of an Internet user that accesses the Internet from a private network through a proxy server, comprising:

receiving a request of the Internet user from a requestor outside of the
private network (Col. 8, lines 17-22; Col. 12, lines 25-30);

determining that the request for the geographic location is from the Internet user located inside

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the private network having the proxy server (Col. 8, lines 17-22; Col. 12, lines 25-30; Col. 9, lines 40-42);

redirecting the request to an internal server in the private network (Col. 3, lines 64-67);

25. McCanne does not teach request for the geographic location; the internal server determining the geographic location of the Internet user; receiving the geographic location from the internal server within the private network; and sending the geographic location to the requestor who is outside the private network.

26. Lamm teaches request for the geographic location; the internal server determining the geographic location of the Internet user; receiving the geographic location from the internal server within the private network; and sending the geographic location to the requestor who is outside the private network (pg 3 "Geographic Location Mapping", 2nd and 4th paragraph; pg 3, "Motivations", 2nd paragraph).

27. As per claim 9, McCanne teaches wherein redirecting the request for information to the internal server comprises sending the request for information to the Internet user's machine, the Internet user's machine directing the request for information to the internal server (Col. 11, lines 58-65).

28. As per claim 10, McCanne teaches the invention substantially as claimed wherein a method for resolving a domain name inquiry to assist in gathering geographic location of an Internet user.

Comprising:

receiving the domain name inquiry. the domain name inquiry being issued by the Internet user (Col. 12, lines 25-30; Col. 8, lines 17-22);

determining if the inquiry originated from within a private network (Col. 12, lines 25-30; Col. 11, lines 57-65);

resolving the inquiry by returning a first IP address if the inquiry did not originate from within the

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private network, the first IP address being associated with an external server located outside of the private network (Col. 12, lines 25-30; Col. 9, lines 33-47); and

resolving the inquiry by returning a second IP address if the inquiry did originate from within the private network, the second IP address being associated with an internal server located inside the private network (Col. 12, lines 25-30; Col. 5, lines 2-3; Col. 3, lines 64-67);

29. McCanne does not teach wherein the internal server and the external server are for determining the geographic location of the Internet user and for making this geographic location information available.

30. Lamm teaches wherein the internal server and the external server are for determining the geographic location of the Internet user and for making this geographic location information available (pg 3 "Geographic Location Mapping", 2nd and 4th paragraph; pg 3, "Motivations", 2nd paragraph).

31. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of McCanne and Lamm because they both dealing with servers offering services towards a client request. Furthermore, the teaching of Lamm to allow internal server determining the geographic location of the Internet user; receiving the geographic location from the internal server within the private network; and using the geographic location of the Internet user in handling the request for information from the Internet user would improve the functionality for McCanne's system by extending the server services which was generically stated in McCanne to discovery of geographic location of clients.

32. As per claim 11, McCanne teaches wherein receiving the inquiry on the domain name comprises receiving the inquiry at a domain name server (Col. 9, lines 33-47).

33. As per claim 12, McCanne teaches wherein the resolving by returning the first IP address and the

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resolving by returning the second IP address are performed by a domain name server (Col. 9, lines 33-37).

Conclusion

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents and publications are cited to further show the state of the art with respect to

“Determining Geographic Locations of Private Network Internet Users”.

- | | | |
|-------|-----------------|-------------------|
| i. | US 2002/0007374 | Marks et al. |
| ii. | US 6,505,201 | Haitsuka et al. |
| iii. | US 6,629,136 | Naidoo. |
| iv. | US 2002/0143991 | Chow et al. |
| v. | US 6,513,061 | Ebata et al. |
| vi. | US 6,286,047 | Ramanathan et al. |
| vii. | US 6,243,749 | Sitaraman et al. |
| viii. | US 6,324,585 | Zhang et al. |
| ix. | US 6,578,066 | Logan et al. |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (703) 305-0718. The examiner can normally be reached on M-F 7am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on 703-305-9678. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CZ
November 21, 2003


ZARNI MAUNG
PRIMARY EXAMINER